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## UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: CHISM, Billy D. Art Unit: 1654

Re: Application of:

ZHAO, Hong, et al.

Serial No.:

10/705,743

Filed:

November 11, 2003

For:

POLYMERIC PRODRUGS OF

VANCOMYCIN

Confirmation No.:

4306

## **RESPONSE**

#### **VIA FACSIMILE 571-273-8300**

Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 July 28, 2006

Sir:

Responsive to the Office Action dated June 29, 2006, the following remarks are made:

#### A. RESTRICTION REQUIREMENT

In response to the restriction requirement, Applicants elect to prosecute in this patent application Group I, claims 3-9, 11-13, 16-18 and 20, drawn to methods of making vancomycin-polymer conjugates. This response is made with traverse and it is urged that the claims contained in Groups I-III be examined together. Reconsideration is respectfully requested.

It is noted that all Groups I-III are identically classified in class 514, subclass 2+. As such, the search directed to the invention of the elected Group I will completely overlap a search strategy directed to the invention of the non-elected Groups II and III. Accordingly, Applicants urge that there would not be an undue burden upon the Examiner to search and consider Groups I-III at the same time.

In addition, the Examiner has the discretion to prosecute all of the pending claims in a single patent application. In fact, "[I]f the search and examination of an entire application can be

made without serious burden, the examiner <u>must examine it on the merits</u>, even though it includes claims to independent or distinct inventions." (Emphasis added; Manual of Patent Examining Procedure, § 803, second paragraph).

Thus, for reasons of efficiency in prosecution and searching, it is urged that Groups I-III be examined together and the Examiner is respectfully requested to reconsider and withdraw the present Restriction Requirement.

There is no change in inventorship based upon this selection.

### B. <u>ELECTION SPECIES</u>

The Examiner indicates that claims 1-2, 10, 14-15, 21, and 30-32 are generic.

In response to the election of species requirement, Applicants elect to prosecute the species corresponding to compound 22 as described in Example 16 and Figure 3 in the event that no generic claim is finally held allowable. It is believed that claims 1, 2, 5-10, 13-16 and 32 currently read on the elected species.

Compound 22 is a species of the genus prepared by the method of claim 1, i.e., reacting compound 21 with compound 1. See Fig. 3. Compound 22 has the following structure:

With regard to Formula (I) of claim 1, and claim 2, compound 22 corresponds to:

R<sub>12</sub> is CH<sub>3</sub>;

 $R_{13}$  is OH;

w is 1;

R<sub>1</sub> is a polyethylene glycol residue with a molecular weight of 40,000 Da;

 $L_1$  is NHCH(CH<sub>3</sub>);

Y<sub>1</sub>, Y<sub>2</sub>, Y<sub>3</sub> and Y<sub>4</sub> are O;

Ar is dimethylphenyl;

R<sub>3</sub> and R<sub>4</sub> are H; and

n, o and p are 1.

The reactants, compound 21 and compound 1, contain the elements corresponding to:

R<sub>11</sub> is H; and

 $B_1$  is



This response to the requirement of the election of species is also made with traverse. Reconsideration is therefore respectfully requested. It is believed that all the compounds prepared by claim1 should be examined together and that the differences of species is not such as to require separate examinations. Accordingly, it is urged that, in the interest of efficiency in prosecution, all the species be examined together.

#### C. REJOINDER

Applicants reserve the right to request rejoinder of all appropriate claims removed by the Examiner in the event that the traversal is not deemed persuasive.

# D. <u>FEES</u>

This response is being filed within the shortened period for response. Thus, no further fees are believed to be required. If, on the other hand, it is determined that any further fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275.

Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as

incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this <u>Response</u> is being facsimile transmitted to the Commissioner for Patents on the

date shown below. July 28, 2006

LUCAS & MERCANTI,

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Michael N. Mercanti